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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,067	11/25/2003	Steven Shepley	D-1182 R3	4154
28995	7590	05/19/2005		EXAMINER
RALPH E. JOCKE walker & jocke LPA 231 SOUTH BROADWAY MEDINA, OH 44256			LE, THIEN MINH	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

A

Office Action Summary	Application No.	Applicant(s)	
	10/722,067	SHEPLEY ET AL.	
	Examiner	Art Unit	
	Thien M. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 November 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-17 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 are rejected under 35 U.S.C. 102(b) as being anticipated by Gardner (Gardner – 5,861,614).

Regarding claim 1, Gardner discloses a "self-service terminal in the form of an automated teller machine (ATM) is provided for communicating across a network with a remote terminal. The ATM comprises a card reader having a transport path and a card entry slot at one end of the transport path for receiving a user identification card from an ATM user to enable the ATM user to gain access to the ATM. A card resides in a position adjoining the card reader and is movable between a first position and a second position along the transport path of the card reader. A transport mechanism is provided for moving the card between the first and second positions. A processor unit is provided for controlling the transport mechanism to move the card between the first and second positions in response to command signals received from the remote terminal. The card may be a diagnostic type of card having a size which is substantially identical to the size of a standard magnetic stripe card. The processor unit controls the transport mechanism to move the diagnostic card between the first and second positions perform a maintenance operation of the card reader in response to the command signals from the remote terminal. Alternatively, the card may be a cleaning type of card having a size which is substantially identical to the size of a standard magnetic stripe card. The processor unit controls the transport mechanism to move the cleaning card between the first and second positions to clean parts of the card reader in response to the command signals from the remote terminal."

(Abstract)

According to Gardner, "the ATM 10 comprises a user interface in the form of a front panel 12. The front panel 12 includes a card reader 60, a key pad 16, a cash dispenser 18, a CRT display 20, and a receipt printer 22. As particularly shown in FIG. 1, the card reader 60 has a card entry slot through which a customer 24 can insert a user identification card 26 at the

commencement of a transaction to be conducted by the customer. The cash dispenser 18 has a cash slot through which cash currency notes stored inside the ATM 10 can be delivered to the customer 24 during the transaction. The receipt printer 22 has a receipt slot through which a receipt of the transaction is delivered to the customer 24 at termination of the transaction. “

According to Gardner, “a diagnostic card 99 is located in the upper compartment 86. Preferably, the diagnostic card 99 has a size which is identical to the size of a standard magnetic stripe card. The diagnostic card 99 contains magnetic data which, when read by the card reader 60, enables the microcomputer 32 to determine if components of the card reader are functioning smoothly and properly.”

In an embodiment, “when the diagnostic card 28 is in the position shown in FIG. 11, the card reader 60 reads the magnetic data contained on the diagnostic card. The microcomputer 32 then uses this magnetic data to perform diagnostic tests to determine if components of the card reader 60 are functioning smoothly and properly. If the microcomputer 32 determines that the card reader 60 passes all of the diagnostic tests, the microcomputer provides a signal indicative thereof. Upon this determination, the card reader 60 is ready to accept a user identification card from the next customer after the diagnostic card 99 returns to the resting position shown in FIG. 12. “

As can be seen, Gardner discloses a portable diagnostic article (diagnostic card 99, 28) which can be moved from a location within the ATM machine 10 to its card reader in order to perform diagnostic tests and commands after the diagnostic card is moved into proper reading position. Thus, Gardner discloses the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner (Gardner – 5,861,614; cited above) in view of Werth et al. (Werth et al. – 4,369,442; herein after referred to as "Werth").

Regarding claim 2, see the discussions regarding claim 1. It is noted that the ATM also includes cash dispenser 18 (figure 2 of Gardner).

The claim differs in calling for a diagnostic program for performing test on the cash dispenser.

Though Gardner is silent about the use of the diagnostic card for analyzing the cash dispenser, reference to Werth is cited as evidence showing the conventionality of the claimed limitation. Specifically, Werth discusses the use of a diagnostic program for analyzing various aspects of a dispenser including: "coin actuation, cup drop, ice drop, item dispensing, water add and water termination." (col. 1, lines 55-68)

It would have been obvious to implement diagnostic software for the cash dispenser. The modification is well within the skill levels and expectations of an ordinary skilled artisan, and also in light of the prior art of record. Further, the modification allows diagnostic tests to be done on other parts of the ATM rather than just the card reader, and thus would enhance versatility aspects of Gardner's teachings.

Regarding claims 3 and 6, though Gardner discloses the method of providing the diagnostic card inside the ATM housing, he also discusses the conventional method of having the diagnostic card inserted by a technician at the time of a maintenance service; and thus would embrace all limitations set forth in this claim.

Regarding claims 4 and 7, see the discussions regarding claim 1 and cols. 6-7 of Gardner.

Regarding claims 5, 7, and 11-13, see the discussions regarding claims 1 and 3.

Further, Gardner discloses that upon input from a technician at a remote site or conventionally at the ATM's location, diagnostic tests are performed on the ATM (see col. 6-8).

Regarding claims 8-9, 10, and 14-17, see the discussions regarding claims 1-7 and 11-13 above. The claims differ in calling for CD, a CD reader, an authorization code, data encryption, a browser, etc. Though Gardner is silent about the use of these limitations, it would have been obvious to implement these limitations in his system. This is because the use of a CD/CD Reader in place of a memory card/card reader is merely a substitution of an art recognized functional equivalent; and also is with higher storage capacity. The use of an authorization code for the diagnostic card and encrypting techniques merely are known method for increasing security aspects of ATM operations, including diagnostic operations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Le, Thien Minh
Primary Examiner
Art Unit 2876
May 12, 2005**